



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,266	05/29/2001	Christopher M. White	3382-56619-01	8058
26119 7590 08/04/2010 KLARQUIST SPARKMAN LLP 121 S.W. SALMON STREET SUITE 1600 PORTLAND, OR 97204				
EXAMINER				
SCHNURR, JOHN R				
ART UNIT		PAPER NUMBER		
2421				
NOTIFICATION DATE		DELIVERY MODE		
08/04/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tanya.harding@klarquist.com
docketing@klarquist.com
valerie.sullivan@klarquist.com

Office Action Summary

Application No.

09/870,266

Applicant(s)

WHITE ET AL.

Examiner

JOHN SCHNURR

Art Unit

2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 7 and 14-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 7 and 14-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Statement(s) (PTO/SF/23)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. This Office Action is in response to the Amendment After Non-Final Rejection filed 05/28/2010. Claims 6, 7, 14-19 and 20-26 are pending and have been examined.
2. The information disclosure statement (IDS) submitted on 05/28/2010 was considered by the examiner.

Response to Arguments

3. Applicant's arguments with respect to claims 6, 7, 14-19 and 20-26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 14-18, 22, 23, 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims require a "computer-readable storage medium." The broadest reasonable interpretation of a computer-readable medium in light of the specification includes a signal per se. As a signal is transitory in nature this creates a non-statutory transitory embodiment of the invention. Please refer to the memorandum from David Kappos, dated 01/26/2010, entitled "Subject Matter Eligibility of Computer Readable Media."

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 6, 14-18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) in view of Wood (US 2002/0054752) in view of Alexander (US 6,177,931) in view of Yoshinobu (US 5,734,444) further in view of Ellis (US 2007/0199030).

Considering claim 6, Herz discloses a method of operating a video system (412—figure 4), the video system including a video input able to receive video information from an interactive head-end (column 41, lines 20-28), a controller (column 45, lines 45-46), a remote control (Fig. 10 1008), a screen (Fig. 10 TV) and a store (902—figure 9), the method comprising: the interactive head-end monitoring a user's viewing habits to determine a normally-watched broadcast video program (column 14, lines 5-7 and column 42, lines 7-10). Herz further discloses generating profiles for plural users, said profiles comprising user viewing habits (column 25, lines 7-13) and other user habits comprising a game habit (column 47, lines 22-26) and customer's zip code (column 11, lines 61-66), the profiles being further based on time-of-day viewing habits (col. 4 lines 60-63 and col. 25 lines 8-13); presenting a listing of available programs that appeared favored by other viewers with profiles similar to the user's viewing habits (column 5, lines 23-52 and column 46, lines 50-57); correlating similar profiles into affinity groupings (column 15 lines 22-33, column 47 lines 45-49); wherein the system can suggest to a viewer other programs (column 22, line 64 – column 23,

line 5) based upon similar preferences determined from said affinity groupings (column 15 lines 22-33, column 25 line 65 – column 26 line 3, column 47 lines 45-49).

Herz further discloses suggesting a video program to the first user that the first user has never watched (column 4, lines 4-15) based upon similar preferences of other viewers within the affinity grouping (column 47, lines 38-42).

Herz fails to disclose defining plural viewing channels, including a favorites channel, which is a channel that includes the user's previously automatically recorded programs; on certain of said channels, presenting television programs for viewing; on at least one of said channels, presenting said copied video program for viewing.

In analogous art, Wood discloses defining plural viewing channels, including a favorites channel, which is a channel that includes the user's previously automatically recorded programs; on certain of said channels, presenting television programs for viewing; on at least one of said channels, presenting said copied video program for viewing. (Fig. 10: The system displays plural channels including user favorites channels made-up of recorded programs, P100-P102, [0058]-[0064].)

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz to include presenting said copied video programs for viewing in favorites channels, as taught by Wood, for the benefit of easily locating recorded programs.

Herz combined with Wood fails to disclose maintaining the copied video programs after viewing; and in response to a query by the first user transmitted from

the interactive controller to the interactive head-end, suggesting a video program to the first user.

In analogous art, Alexander discloses copied video programs are maintained after viewing (the recorded programs may be set to be viewed once, daily, or weekly i.e. the program is maintained after the first viewing for the daily or the weekly viewing—column 21, lines 50-54 and column 12, lines 10-21, where Alexander explicitly discloses copying video programs on a Digital Video Disc (DVD), wherein the copied video programs are obviously maintained after viewing); and in response to a query by the first user transmitted from the interactive controller to the interactive head-end, suggesting a video program to the first user (column 31, lines 25-33).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz combined with Wood to include presenting said copied video programs for viewing and querying a head-end for a suggested video program, as taught by Alexander, for the benefit of minimizing channel surfing.

Herz combined with Wood and Alexander fails to disclose the controller copying the video program to the store if the user is not viewing said program when broadcast. Herz combined with Alexander also fails to disclose that the user need not plan in advance to record a normally-watched program, because the normally-watched program is automatically recorded if it is not viewed by the user when broadcast.

In analogous art, Yoshinobu discloses copying the video program to the store if the user is not viewing said program when broadcast. Yoshinobu also discloses that the user need not plan in advance to record a normally-watched program, because the

normally-watched program is automatically recorded if it is not viewed by the user when broadcast (column 24, lines 51-59).

It would have been obvious to one of ordinary skill in the art to modify the system of Herz combined with Wood and Alexander to include an automatic recording of the normally-watched program, as taught by Yoshinobu, for the benefit of not missing a favorite program when broadcast while watching another favorite program.

Herz combined with Wood, Alexander and Yoshinobu fails to disclose permitting a viewer to break from the video program by receiving a pause command from the viewer and sending the pause command to the interactive head-end to interrupt delivery of the video program.

In analogous art, Ellis discloses permitting a viewer to break from the video program by receiving a pause command from the viewer and sending the pause command to the interactive head-end to interrupt delivery of the video program. ([0165]).

It would have been obvious to one of ordinary skill in the art to modify the system of Herz combined with Wood, Alexander and Yoshinobu by permitting a viewer to break from the video program by receiving a pause command from the viewer and sending the pause command to the interactive head-end to interrupt delivery of the video program, as taught by Ellis, for the benefit of allowing the viewer to view other content or leave the room.

Considering claim 14, Herz discloses a computer readable storage medium including executable instructions that cause a digital processor to perform a method (figure 11 and column 10, lines 6-20 and column 49, lines 32-51), the executable instructions comprising: instructions for monitoring a user's viewing habits to determine a favorite video program (column 14, lines 5-7 and column 42, lines 7-10); instructions for defining plural viewing channels (virtual channels); instructions for generating profiles for plural users connected to the interactive head-end (column 25, lines 7-13), said profiles comprising user viewing habits including at least time-of-day viewing habit (col. 4 lines 60-63 and col. 25 lines 8-13) and at least two other user features comprising a game habit (column 47, lines 22-26), a chat habit, zip code (column 11, lines 61-66), an interactive news habit, or a jukebox habit; instructions for correlating profiles similar to the first user into an affinity grouping (column 15 lines 22-33, column 47 lines 45-49); and suggesting a video program to the first user (column 22, line 64 – column 23, line 5) based upon similar preferences of other viewers within the affinity grouping (column 15 lines 22-33, column 25 line 65 – column 26 line 3, column 47 lines 45-49).

Herz further discloses suggesting a video program to the first user that the first user has never watched (column 4, lines 4-15) based upon similar preferences of other viewers within the affinity grouping (column 47, lines 38-42).

Herz fails to disclose instructions for defining plural viewing channels, including a favorites channel, which is a channel that includes the user's previously automatically recorded programs; on certain of said channels, presenting television programs for

viewing; on at least one of said channels, presenting said copied video program for viewing.

In analogous art, Wood discloses defining plural viewing channels, including a favorites channel, which is a channel that includes the user's previously automatically recorded programs; on certain of said channels, presenting television programs for viewing; on at least one of said channels, presenting said copied video program for viewing. (Fig. 10: The system displays plural channels including user favorites channels made-up of recorded programs, P100-P102, [0058]-[0064].)

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz to include presenting said copied video programs for viewing in favorites channels, as taught by Wood, for the benefit of easily locating recorded programs.

Herz fails to disclose maintaining the copied video programs are after viewing; and in response to a query by the first user transmitted from the interactive controller to the interactive head-end, suggesting a video program to the first user.

In analogous art, Alexander discloses defining plural viewing channels (column 15, lines 47-48); on certain of said channels, presenting television programs for viewing (column 30, lines 55-58); on at least one of said channels, presenting said copied video program for viewing (column 21, lines 50-54 and column 22, lines 29-33); the copied video programs are maintained after viewing (the recorded programs may be set to be viewed once, daily, or weekly i.e. the program is maintained after the first viewing for the daily or the weekly viewing—column 21, lines 50-54 and column 12, lines 10-21,

where Alexander explicitly discloses copying video programs on a Digital Video Disc (DVD), wherein the copied video programs are obviously maintained after viewing); and in response to a query by the first user transmitted from the interactive controller to the interactive head-end, suggesting a video program to the first user (column 31, lines 25-33).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz to include presenting said copied video programs for viewing and querying a head-end for a suggested video program, as taught by Alexander, for the benefit of minimizing channel surfing.

Herz combined with Alexander fails to disclose instructions for copying the favorite video program to a storage medium if the user is not viewing said program when broadcast wherein the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast.

In analogous art, Yoshinobu discloses instructions for copying the favorite video program to a storage medium if the user is not viewing said program when broadcast wherein the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast (column 24, lines 51-59).

It would have been obvious to one of ordinary skill in the art to modify the system of Herz combined with Alexander to include an automatic recording of the favorite

program, as taught by Yoshinobu, for the benefit of not missing a favorite program when broadcast while watching another favorite program.

Herz combined with Wood, Alexander and Yoshinobu fails to disclose permitting a viewer to break from the video program by receiving a pause command from the viewer and sending the pause command to the interactive head-end to interrupt delivery of the video program.

In analogous art, Ellis discloses permitting a viewer to break from the video program by receiving a pause command from the viewer and sending the pause command to the interactive head-end to interrupt delivery of the video program. ([0165]).

It would have been obvious to one of ordinary skill in the art to modify the system of Herz combined with Wood, Alexander and Yoshinobu by permitting a viewer to break from the video program by receiving a pause command from the viewer and sending the pause command to the interactive head-end to interrupt delivery of the video program, as taught by Ellis, for the benefit of allowing the viewer to view other content or leave the room.

As for claim 15, Yoshinobu further discloses monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking (column 11 line 64 to column 12 line 14 and column 15 lines 38-47 and column 24 lines 51-59). Therefore, the recording of programs is in

accordance with said ranking. Wood discloses listing the copied video program in an electronic program guide associated with the system, together with a viewing channel on which the copied video can be viewed (Fig. 10 [0058]-[0064]).

With regards to claim 16, it is met by the combination of Herz, Wood, Alexander and Yoshinobu. In particular, Yoshinobu discloses listing the automatically copied favorite video program in the favorite channel by title (column 24, lines 21-26) and length (start time and end time—column 14, lines 48-50).

Regarding claim 17, it is met by the combination of it is met by the combination of Herz, Wood, Alexander and Yoshinobu. In particular, Yoshinobu discloses automatically playing the copied favorite video program when the favorites channel is selected (column 14, lines 54-57).

Considering claim 18, it is met by the combination of it is met by the combination of Herz, Wood, Alexander and Yoshinobu. In particular, Yoshinobu discloses listing plural copied video programs (Yoshinobu—see figure 10) from which the copied favorite video program can be selected for playback (column 14, lines 48-57).

With regards to claim 20, it is met by the combination of Herz, Wood, Alexander and Yoshinobu. In particular, Herz discloses that the specific program is suggested to the viewer (column 22, line 64 – column 23, line 5 and column 47, lines 37-45) in

response to a viewer's inquiry (column 47, lines 37-45 and column 48, line 48 – column 49, line 1).

Regarding claim 21, it is met by the combination of Herz, Wood, Alexander and Yoshinobu. In particular, Herz discloses that the specific program is suggested to the viewer (column 22, line 64 – column 23, line 5 and column 47, lines 37-45) autonomously (column 49, lines 52-54).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) in view of Wood (US 2002/0054752) in view of Alexander (US 6,177,931) further in view of Yoshinobu (US 5,734,444) further in view of Ellis (US 2007/0199030) and further in view of Smith (US 5,933,141).

Consider claim 7, Herz combined with Wood, Alexander, Yoshinobu and Ellis clearly teaches the method of claim 6. Alexander further discloses displaying a translucent menu in response to receiving an indication that a remote control button has been pressed and highlighting a region of the menu (column 3 lines 21-55).

However, Alexander fails to disclose the menu is a control menu with a play button.

In an analogous art, Smith discloses displaying a control panel with a play button (Figs. 4A-4C column 6 line 51 to column 7 line 25).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz combined with Alexander and Yoshinobu to include a control panel with a play button, as taught by Smith, for the benefit of preventing the display screen from becoming cluttered (see column 1 lines 49-63 Smith).

9. Claims 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) in view of Wood (US 2002/0054752) in view of Alexander (US 6,177,931) further in view of Yoshinobu (US 5,734,444) further in view of Ellis (US 2007/0199030) and further in view of Okada (US 7,095,949).

As for claims 24-26, Herz, Wood, Alexander, Yoshinobu and Ellis fail to disclose deleting at least one of the plural programs copied to the store by time of copy, wherein the oldest copy is deleted.

In analogous art, Okada discloses deleting stored video content by time of copy, wherein the oldest copy is deleted (column 8 lines 45-47).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Wood, Alexander, Yoshinobu and Ellis to include deleting stored video content by time of copy, wherein the oldest copy is deleted, as taught by Okada, for the benefit of allowing the newest programming to be recorded.

As for claims 22 and 23, Herz, Wood, Alexander, Yoshinobu and Ellis fail to disclose deleting at least one of the plural programs copied to the store by time of copy, wherein the oldest copy is deleted.

In analogous art, Okada discloses deleting stored video content by time of copy, wherein the oldest copy is deleted (column 8 lines 45-47).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Wood, Alexander, Yoshinobu and Ellis to include deleting stored video content by time of copy, wherein the oldest copy is deleted, as taught by Okada, for the benefit of allowing the newest programming to be recorded.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN SCHNURR whose telephone number is (571)270-1458. The examiner can normally be reached on M-F 9a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

JRS